

REMARKS

Claims 1, 3, 4, 8, 9, 12-18 and 20-38 are pending.

Claims 2, 5-7, 10-11, and 19 have been cancelled.

In the Office Action dated December 8, 2009, claims 1, 3, 6, 8, and 30 were rejected under 35 U.S.C. § 102(e) as anticipated by Dolan (U.S. Patent No. 2002/0057653); claims 4-5, 7, 9, and 12-15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dolan and further in view of Bender (U.S. Patent Publication No. 2006/0148511).

After several iterations in various Office Actions involving § 103 rejections based on Dolan (*e.g.*, § 103 rejection based on Gilhousen and Dolan in the 5/1/2009 Office Action, § 103 rejection over Dolan alone in the 7/18/2007 Office Action, and § 103 rejection over Grob and Dolan in the 1/8/2007 Office Action), the present Office Action now alleges that claim 1 is anticipated by Dolan. The Dolan reference was first applied in a § 103 rejection over Grob and Dolan against claim 1 in the 1/5/2006 Office Action. Since then, there has been eight Office Actions, 3 Pre-Appeal Brief Requests for Review, and three Decisions from Pre-Appeal Brief Review, each requiring the Examiner to reopen prosecution and withdraw the respective final rejections. Such churning of rejections over a long history is causing great expense. Applicant respectfully requests that the Examiner either maintains a rejection and allows this case to proceed to the Board of Appeals for decision, or to allow the claims of the case since it is clear that all of the references of record do not provide any teaching or hint of the claimed subject matter.

In converting the rejection of claim 1 from purportedly being obvious over Dolan (either alone or in combination with other references) into a § 102 rejection based on Dolan, the Examiner made the following assertion:

Examiner now understands that Dolan does explicitly describe a wireless infrastructure with incompatible system components, hence equating to the claimed “different type of wireless system” as argued.

12/8/2009 Office Action at 6. The allegation that Dolan discloses the claimed subject matter is clearly erroneous.

Applicant will address independent claim 24 first. The Office Action argued that claims 24-29 “are article claims drawn to the limitations deriving from method claims 1-15,” and

therefore “they are rejected using the same rationale.” *Id.* at 5. The Office Action also made a similar statement with respect to claims 16-23.

It appears that the rejection of claim 24 is a § 102 rejection over Dolan. At this late stage in the prosecution of the present application, such vague rejections of different sets of claims are clearly improper. At a minimum, to place this case in better condition for appeal, Applicant respectfully requests that each and every claim be specifically addressed in the next Office Action (assuming that the rejection will be maintained), with citations to the cited references provided.

Nevertheless, the following provides a detailed discussion of why Dolan fails to anticipate the subject matter of claim 24.

Independent claim 24 recites an article comprising at least one storage medium containing instructions that when executed cause a first base station system to:

- exchange signaling according to a first protocol with a mobile station to establish a packet-switched communications session between the mobile station and another endpoint;
- determine if a handoff is required to a second base station system that performs wireless communications with the mobile station according to a second, different protocol; and
- exchange messaging with the second base station system through a link between the first and second base station systems to perform the handoff.

As the Examiner previously conceded, “Dolan fails to explicitly describe that the first and second BS are of different vendors using different customized protocols.” 7/18/2007 Office Action at 3. What the 7/18/2007 Office Action appeared to concede, with respect to claim 24, is that Dolan fails to disclose a first base station system (that communicates according to a first protocol) determining if a handoff is required to a second base station system that performs wireless communications according to a second, different protocol, as recited in claim 24.

The Examiner’s concession made in the 7/18/2007 Office Action was correct. Although the Background section of Dolan refers to a multi-vendor wireless telecommunications network (Dolan, ¶ [0008]), it is noted that the concern raised in Dolan is the lack of compatibility in communications **between MSC and base stations** from different vendors. There is absolutely

no hint that the equipment made by different vendors would communicate wireless communications with a **mobile station** according to different protocols.

As stated by the Summary section of Dolan, “[t]his need is addressed and a technological advance is achieved by interconnection protocols for supporting packet switched messages **between the MSC and base stations** in wireless telecommunications systems.” *Id.*, ¶ [0010] (emphasis added). A first packet interconnection protocol establishes an interface between a selection distribution unit (SDU) and a base station interconnection processor. *Id.* A second packet interconnection protocol establishes an interface between the SDU and a base station controller. *Id.* By using packet-based technologies for the exchange of data **between SDUs and base stations, MSCs and base station can be interconnected in a variety of configurations** to support individual wireless network requirements. *Id.*

The foregoing is illustrated in Fig. 2 of Dolan, where a link 231 between the SDU 224 in the source base station 220 and the call controller 242 in the target base station 240 uses the second protocol, while the link 233 between the SDU 224 in the source base station and the interconnection processor 244 in the target base station uses the first protocol. *Id.*, ¶¶ [0022], [0025]. As noted by Dolan, the use of an SDU and the first and second packet interconnection protocols enhances flexibility. *Id.*, ¶ [0034]. Thus, the two protocols referred to in Dolan refers to a first protocol to communicate between an SDU and an interconnection processor of a base station, and a second protocol to communicate between the SDU and a call controller of a base station. The flexibility provided by the arrangement of Dolan allows a service provider “to position systems in a variety of locations within a wireless network.” *Id.*, ¶ [0011].

However, Dolan does not provide any hint of source and target base stations that communicate according to first and second different protocols **with the mobile station**, as recited in claim 24. Also, the reference to “older” equipments in ¶ [0007] of Dolan does not provide any teaching or hint of base stations communicating according to different protocols with the **mobile station**.

In view of the foregoing, it is clear that claim 24 is not anticipated by Dolan.

The Office Action also failed to address dependent claim 37 (which depends from claim 24). Claim 37 recites that signaling is exchanged with a hybrid mobile station that is able to perform wireless communications according to both the first and second protocols. Nowhere in

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the Office Action was there any explanation regarding what in Dolan constitutes the “hybrid mobile station” of claim 37. The Office Action also similarly failed to address dependent claims 33 and 35 (and their dependent claims).

Since it is clear that Dolan provides absolutely no hint of a hybrid mobile station that is able to support two different wireless communications protocols, this is further indication that Dolan does not anticipate the subject matter of claim 24.

Independent claims 1 and 16 are allowable over Dolan for similar reasons.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the allowability of base claims over Dolan, the obviousness rejection of dependent claims over Dolan and Bender have been overcome.

Allowance of all claims is respectfully requested.

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (ERC.0003US).

Respectfully submitted,

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